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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,829	04/02/2004	Michael D. Wall	22187.00	8875

7590 09/22/2005  
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EXAMINER

KENNEDY, JOSHUA T

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/815,829

Applicant(s)

WALL, MICHAEL D.

Examiner

Joshua T. Kennedy

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JK

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6, 7, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8-12, 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I drawn to Figures 2-4, 9, and 12

Species II drawn to Figures 5-7, 8a, 14, and 15.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 9, and 15 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Ed Favors on 8/30/05 a provisional election was made with oral traverse to prosecute the invention of Species I, claims 1-3 and 5-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4, 6, 7, 13, and 14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-3, 5, 8-12, and 15-18 have been examined.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 8-12, 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Brema et al (US Patent 4,498,660).

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As to Claim 1. Brema et al disclose a barrier system having pre-existing fence post comprising:

a first fence panel having a first end and a second end (Fig 5; Examiner considers the left side of the post (9) to be the first panel);

a second fence panel having a first end and a second end (Fig 5; Examiner considers the right side of the post (9) to be the second panel);

a cavity formed in each first end (Fig 3) whereby said first end of each panel is adapted to fit around a respective pre-existing fence post (9);

first releasable attachment structure disposed on said first end of said first fence panel (Fig 5);

second releasable attachment structure disposed on said first end of said second fence panel (Fig 5), whereby adjacent panels are adapted be releasably secured to said respective pre-existing post (Col 1, Lines 42-46).

As to Claim 2. Brema et al disclose said first releasable attachment structure comprising connector projections (10a and 10b).

As to Claim 3. Brema et al disclose second releasable attachment structure comprising connector slots (8).

As to Claim 5. Brema et al disclose each panel being horizontally corrugated (Fig 5).

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As to Claim 8. Brema et al disclose a post cap (13) releasably secured to each of said pre-existing fence posts.

As to Claim 9. Brema et al disclose a barrier system having pre-existing fence posts comprising:

a first fence panel having a first end, a second end and a height (Fig 5; Examiner considers the left side of the post (9) to be the first panel);

a second fence panel having a first end, a second end and a height (Fig 5; Examiner considers the right side of the post (9) to be the second panel);

a cavity formed in each first end, said cavity being coextensive with said height of said respective first fence panel and second fence panel (Fig 5; Examiner considers the cavity formed by the ends (3a and 3b) in combination to be coextensive with the height of the panels), whereby said first end of each panel is adapted to fit around a respective pre-existing fence post (9);

first releasable attachment structure disposed on said first end of said first fence panel and said first end of said second fence panel (Fig 5); and

second releasable attachment structure disposed on said first end of said first fence panel and said first end of said second fence panel (Fig 5), whereby adjacent panels are adapted be releasably secured to said respective pre-existing post (Col 1, Lines 42-46); and

including a post cap (13) releasably secured to each of said pre-existing fence posts.

As to Claim 10. Brema et al disclose said first releasable attachment structure comprising connector projections (3a and 3b) and wherein said connector projections extend approximately one-half the height of said first fence panel and said second fence panel (Figs 1 & 2).

As to Claim 11. Brema et al disclose said second releasable attachment structure comprising connector slots (3a and 3b) and wherein said connector slots extend approximately one-half the height of said first fence panel and said second fence panel (Figs 1 & 2).

As to Claim 12. Brema et al disclose each panel being horizontally corrugated (Fig 5).

As to Claim 15. Brema et al disclose a barrier system having pre-existing fence posts comprising:

- a first fence panel having a first end, a second end and a height (Fig 5; Examiner considers the left side of the post (9) to be the first panel);

- a second fence panel having a first end, a second end and a height (Fig 5; Examiner considers the right side of the post (9) to be the second panel);

- a cavity formed in each first end, said cavity being coextensive with said height of said respective first fence panel and second fence panel (Fig 5; Examiner considers the cavity formed by the ends (3a and 3b) in combination to be coextensive with the height

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of the panels), whereby said first end of each panel is adapted to fit around a respective pre-existing fence post (9);

first releasable attachment structure disposed on said first end of said first fence panel and said first end of said second fence panel (Fig 5); and

second releasable attachment structure disposed on said first end of said first fence panel and said first end of said second fence panel (Fig 5), whereby adjacent panels are adapted be releasably secured to said respective pre-existing post (Col 1, Lines 42-46).

As to Claim 16. Brema et al disclose a panel (1). The applicant is reminded that patentability determination of product-by-process claims is based on the product itself, which in this case is solely the panel, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production. " In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985).

As to Claim 17. Brema et al disclose fasteners for attaching the second end of said first fence panel to a third fence panel (Fig 4; Examiner considers the post (9a) as a fastener to attach the second end of the first fence panel to the third fence panel which continue on the left side of the post (9a), according to the figure).



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As to Claim 18. Brema et al disclose fasteners for attaching the second end of said second fence a fourth fence panel. (Fig 4; Examiner considers the post (9c) as a fastener to attach the second end of the second fence panel to the fourth fence panel which continue on the right side of the post (9a), according to the figure).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,609,702 to Steffes cited to show a post cap.

US Patent 6,877,721 to Calverley cited to show a similar corrugated fence where the corrugation is vertical rather than horizontal.

US Patent 4,329,079 to Milding cited to show similar coupling that could be releasably attached to a fence panel and to an existing fence post.

US Patent 3,704,861 to Glaesener cited to show a corrugated rail for a fence.

US Patent 4,962,914 to Taylor cited to show a fence utilizing a dovetail with corresponding slot for a connection between a fence post and rails.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTK  
9/15/05

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is fluid and cursive, with the first name "Daniel" and last name "Stodola" clearly legible.

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600